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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,470	11/14/2001	Hiroaki Tanaka	0020-4926P	7061
2292	7590	06/17/2004		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER LEE, EDMUND H				
ART UNIT		PAPER NUMBER		
1732				

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/987,470

Applicant(s)

TANAKA ET AL.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 11/14/2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

2. The abstract of the disclosure is objected to because it is not one paragraph. Correction is required. See MPEP § 608.01(b).

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing because the preamble reads as a method claim however, the body of the claim reads as a product claim. What is it, method or product claim?

Correction is required.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz (USPN 6019921). For the sake of expediting prosecution, claim 1 has been examined as a method claim even though the body of the claim reads as a product claim. In regard to claim 1, Lutz teaches the basic claimed process including a method of making

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a coated golf ball (col 2, lns 10-15; col 4, lns 27-29 and 45-57; col 5, lns 20-38; col 5, ln 58-col 6, ln 11; col 7, lns 42-63); providing a golf ball body, of which the surface portion is formed from resin composition ore rubber composition (col 2, lns 10-15; col 4, lns 27-29 and 45-57; col 5, lns 20-38; col 5, ln 58-col 6, ln 11; col 7, lns 42-63); and coating a paint layer on the golf ball body wherein the paint is coated after molding the golf ball body in a mold (col 2, lns 10-15; col 4, lns 27-29 and 45-57; col 5, lns 20-38; col 5, ln 58-col 6, ln 11; col 7, lns 42-63). Lutz, however, does not teach coating within 72 hours of molding. Coating time is well-known in the molding art as an important coating parameter and the desired time would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed time is generally well-known in the coating art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the golf ball body of Lutz within 72 hours of molding in order to produce a high quality golf ball. It should be noted that MPEP 2144.05 states that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" and the parameter must be a result effective variable; and the instant specification has disclosed that coating time is a result-effective variable (pg 2, lns 7-15 of the instant specification). In regard to claims 2-4, such are taught by Lutz (col 2, lns 10-15; col 4, lns 27-29 and 45-57; col 5, lns 20-38; col 5, ln 58-col 6, ln 11; col 7, lns 42-63).

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota (USPN 5695414). For the sake of expediting prosecution, claim 1 has been

examined as a method claim even though the body of the claim reads as a product claim. In regard to claim 1, Yokota teaches the basic claimed process including a method of making a coated golf ball (col 3, lns 15-25, 30-32, and 60-62; col 4, lns 8-13); providing a golf ball body, of which the surface portion is formed from resin composition or rubber composition (col 3, lns 15-25, 30-32, and 60-62; col 4, lns 8-13); and coating a paint layer on the golf ball body wherein the paint is coated after molding the golf ball body in a mold (col 3, lns 15-25, 30-32, and 60-62; col 4, lns 8-13). Yokota, however, does not teach coating within 72 hours of molding. Coating time is well-known in the molding art as an important coating parameter and the desired time would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed time is generally well-known in the coating art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the golf ball body of Yokota within 72 hours of molding in order to produce a high quality golf ball. It should be noted that MPEP 2144.05 states that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" and the parameter must be a result effective variable; and the instant specification has disclosed that coating time is a result-effective variable (pg 2, lns 7-15 of the instant specification). In regard to claims 2-4, such are taught by Yokota (col 3, lns 15-25, 30-32, and 60-62; col 4, lns 8-13).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohira et al (USPN 5985370) teach the state of the art.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE  
Primary Examiner  
Art Unit 1732



6/14/04

EHL